

REMARKS

The Examiner is thanked for the due consideration given the application. No new matter is believed to be added to the application by this Amendment.

Entry Of Amendment

Entry of this Amendment under 37 C.F.R. §1.116 is respectfully requested because it cancels claims and places the application in condition for allowance. Alternately, entry is requested as reducing issues for appeal.

Status Of The Claims

Upon entry of this Amendment, claims 16, 17 and 21 are pending in the application. This Amendment cancels claims 18-20 without prejudice or disclaimer of any of the subject matter contained therein. Claim 16 has been amended to incorporate subject matter from claim 19. Claim 17 has been amended to incorporate subject matter from claim 20. Support for the amendments to claim 16 and 17 can also be found in the specification at page 21, line 23 to page 22, line 8.

Rejections Under 35 U.S.C. § 102(b)

Claims 16-21 have been rejected under 35 U.S.C. §102(b) as being anticipated by Hakuta '251 (WO 00/55251, equivalent to U.S. Patent 6,864,315).

Also, claims 16-21 have been rejected under 35 U.S.C. §102(b) as being anticipated by Hakuta '407 (WO 01/98407, equivalent to U.S. Patent 6,743,862).

Each of these rejections is respectfully traversed, and reconsideration and withdrawal thereof are respectfully requested.

Hakuta '251 pertains to a rubber composition that includes an ethylene/ α -olefin/non-conjugated polyene copolymer, an organopolysiloxane, an SiH group-containing compound, a catalyst and a reaction inhibitor.

Hakuta '251 fails to disclose an ethylene/ α -olefin/non-conjugated polyene copolymer (A) having an intrinsic viscosity (η) of 0.01 to less than 0.3 dl/g as measured in decalin at 135°C, such as is set forth in independent claims 16 and 17 of the present invention.

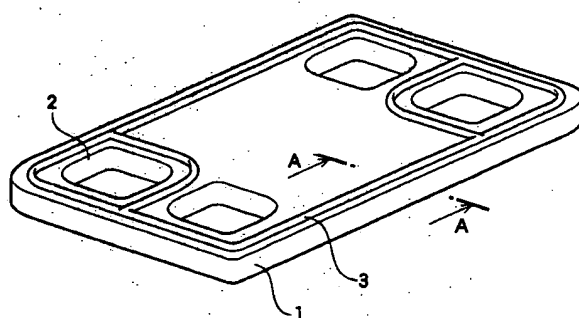
In contrast, Hakuta '251 discusses an intrinsic viscosity (η) in a range of 0.3 to 10 dl/g as measured in decalin at 135°C (*see* equivalent U.S. Patent 6,864,315 at column 14, line 48 to column 15, line 40).

Hakuta '407 pertains to a rubber composition that includes ethylene/ α -olefin/non-conjugated polyene copolymer and an SiH group-containing compound, or to a rubber composition that includes ethylene/ α -olefin/non-conjugated polyene copolymer, an SiH group-containing compound and a catalyst, or to a rubber composition that includes ethylene/ α -olefin/non-conjugated polyene copolymer, an SiH group-containing compound, a catalyst, a reaction inhibitor and/or a silane coupling agent (*see* equivalent U.S. Patent 6,743,862 at column 2, line 64 to column 4, line 53).

Hakuta '407 fails to disclose each and every component of the claimed invention, which includes an ethylene/ α -olefin/non-conjugated polyene copolymer (A), an organopolysiloxane (B), an SiH group-containing compound (C), a catalyst (D) and a reaction inhibitor (E).

Also, both Hakuta '251 and Hakuta '407 fail to disclose or suggest a method for making a sealing or gasket material for a fuel cell seal or a top cover gasket for a hard disk drive by molding the rubber composition into a molded product by using liquid injection molding. Liquid injection molding is recited in claims 16 and 17 of the present invention, and these claims fail to be anticipated by Hakuta '251 or Hakuta '407 for this additional reason.

Moreover, when manufacturing a fuel cell seal, for example, having a long and thin shape, which is to be integrated with a separator as shown in present Fig. 1, a person having skill in the art will be faced with problems with poor mechanical strength when making and using a conventional injection molding (SIM) due to high molding pressure, which is necessarily used when a rubber composition such as that of Hakuta '251 includes an ethylene/ α -olefin/non-conjugated polyene copolymer rubber (A) having an intrinsic viscosity outside the range of present claim 16 or 17.



*Fig. 1 of the Present
Invention*

However, the present inventors unexpectedly found that by making the ethylene/ α -olefin/non-conjugated polyene copolymer rubber (A) of the rubber composition to have an intrinsic viscosity in the range of 0.01 to less than 0.3 dl/g, it is possible to produce a

fuel cell seal in a long and thin shape by liquid injection molding (LIM) using a lower molding pressure and, thereby, causing no damage to the separator.

As a result, both Hakuta '251 and Hakuta '407 fail to disclose each and every element of claims 16 and 17 of the present invention. Each of Hakuta '251 and Hakuta '407 thus fails to anticipate claims 16 and 17 of the present invention. Claim 21 depends upon claim 16 and is thus patentable for at least the above reasons.

These rejections are overcome and withdrawal thereof is respectfully requested.

Information Disclosure Statements

The Examiner is thanked for considering the Information Disclosure Statements filed March 10, 2005, December 29, 2004, October 8, 2004 and June 25, 2004 and for making the initialed PTO-449 forms of record in the application in the Office Action mailed January 13, 2006.

Foreign Priority

The Examiner has acknowledged foreign priority most recently in the Office Action mailed July 10, 2006.

The Drawings

The Examiner is respectfully requested to indicate whether the drawing figures are acceptable in the next official action.

Conclusion

The Examiner's rejections have been overcome, obviated or rendered moot. No issues remain. It is believed that a full and complete response has been made to the outstanding Office Action. The Examiner is accordingly respectfully requested to place the application in condition for allowance and to issue a Notice of Allowability.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E. Goozner (Reg. No. 42,593) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: October 10, 2006

Respectfully submitted,

By Robert E. Goozner #42,593
for Marc S. Weiner
Registration No.: 32,181
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

msw